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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,138	04/12/2001	Peter J. Nunes	IL-10691	1976

7590 03/19/2003
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EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
1743	5

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/834,138

Applicant(s)

NUNES ET AL.

Examiner

Lyle A Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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In response to the 1/31/03 IDS, the Office has found the cited references applicable as well as other references discovered when the field of search was updated.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/126,792. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a SPME device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawliszyn, (Optimization of the SPME Device Applications" (cited by Applicants 1/31/03) or Koehler et al. in view of Rieck further in view of Whitcher et al. or Sardisco et al.

The cited art teaches SPME fibers within syringe housings and septums. The art is silent to the assembly of a plurality of SPME fiber syringe assemble in a kit.

Riech teaches means to protect a syringe assembly during transport. There is a top and bottom portion that are sealed by a twisting/lock arrangement having an "o"-ring seal(42). The assembly has the advantages of preventing premature discharge of the syringe's contents and provides easy/safe disposal and transporation of contaminated syringes.

It would have been within the skill of the art to modify Pawliszyn, "Optimization of the SPME Device Applications" or Koehler et al. in view of Reich and provide a protective container having an interconnecting top and bottom portion to gain the advantages of preventing premature discharge of the syringe's contents and provides easy/safe disposal of contaminated syringes.

The court decided St. Regis Paper Co. v. Bemis Co., Inc. (193 USPQ 8,11) and In re Harza (124 USPQ 378) that duplication of parts has no patentable significance unless a new and unexpected result is achieved. It is advantageous to duplicated parts in a test kit so that multiple tests may be performed from the same packaging which avoids waste and makes the testing more economical.

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It would have been within the skill of the art to Pawliszyn, "Optimization of the SPME Device Applications" or Koehler et al. and supply a plurality of SPME's to gain the above advantages.

Pawliszyn, "Optimization of the SPME Device Applications" or Koehler et al. in view of Reich is silent to assembling all of the necessary components to perform the testing in a kit.

Whitcher et al. and Sardisco et al. teach test kits supplying all of the necessary items as well as instructions for use in a carrying case. The advantages of such as test kit it they supply all of the necessities to perform the test and obviate the problem of trying to assemble the components in a hasty fashion possibly missing essential elements. Kits are also advantageous because they are commercially expedient.

It would have been within the art to Pawliszyn, "Optimization of the SPME Device Applications" or Koehler et al. in view of Rieck further in view of Whitcher et al. or Sardisco et al. and bring together all of the essentials in the form of a kit to gain the above advantages.

Response to Arguments

Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Novak teaches a kit (see figure 1) for the detection of analytes.

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Column 4 lines 12-15 teach that in addition to solid phase extraction, SPME techniques could also be used.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Lyle A Alexander
Primary Examiner
Art Unit 1743

March 17, 2003